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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,438	08/24/2004	Tetsuro Asano	492322017400	2447

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EXAMINER

MAI, ANH D

ART UNIT PAPER NUMBER

2814

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/505,438	Applicant(s) ASANO ET AL.	
	Examiner Anh D. Mai	Art Unit 2814	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2042 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/24/2004</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Status of the Claims*

1. The Preliminary Amendment filed August 24, 2004 has been entered. Claims 1-19 have been cancelled. Claims 20-42 have been added. Claims 20-42 are pending.

### *Priority*

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

### *Specification*

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For example: page 4, line 14, "diffusion in a substrate 201", the correct portion should be -- diffusion in a substrate 101 --.

4. First line of the specification must contain status information of the current application and the priorities.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 32, 37 and 39-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 32 and 37, there does not appear to be a written description of the claim limitation “a distance between the outer side surface of the first high concentration impurity region (claim 32) or between a side surface of the branch portion (claim 37) and an edge of the insulating region closest to the first high concentration impurity region is 10  $\mu$ m or larger.” in the application as filed.

As seen in Fig. 23A, the outer side surface of the first high concentration impurity region has been defined in claim 20 to be the side other than the one that faces the second impurity region. Claim 20 also defined that the first impurity region is formed in an insulating region.

Therefore, the distance between the side surface of the branch portion or the outer side surface of the first high concentration impurity region and the edge of the insulating region closest to the first high concentration impurity region is the interface between them, thus, 0  $\mu$ m not 10  $\mu$ m or larger.

With respect to claims 39-42, there does not appear to be a written description of the claim limitation “a distance in the direction of the flow (claims 39 and 40) or **normal** to the flow (claims 41 and 42) of electric current between the first high concentration impurity region and an edge of the insulating region closest to the first high concentration impurity region is 10  $\mu$ m or larger.” in the application as filed.

The flow of electric current is from the first high concentration impurity region to the second high concentration impurity region.

The term “direction normal to the flow” means perpendicular to the flow or from the top of the insulating region into the bottom.

The term “between the *first* high concentration impurity region and an **edge** of the insulating region *closest to the first* high concentration impurity region” is the interface between the two, which is 0  $\mu\text{m}$ , since the interface has no thickness.

Applicant must remove or provide support for the new matter in response to the Office Action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 32, 37 and 39-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 32 and 37, both claims recite similar subject matter: wherein the distance between outer side surface of the first high concentration impurity region (claim 32) or a side surface of the branch portion (claim 37) and an edge of the insulating region closest to the branch portion is 10  $\mu\text{m}$  or larger (both claims).

As discussed above, the interface has no thickness.

Secondly, the claimed limitation is not understood.

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With respect to claims 39-42, claims 39-42 recite the limitation: “a distance in the direction of the flow or normal to the flow, of electric current between the first high concentration impurity region and an edge of the insulating region closest to the first high concentration impurity region is 10  $\mu\text{m}$  or larger”.

The limitation is not understood, thus indefinite.

The merits of these claims (37 and 39-42) therefore could not be determined.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 20-22, 26-30, 32, 34, 35 and 37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 11, 14, 19, 21-26, 29, 30, 34 and 35 of U.S. Patent No. 6,914,280. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because the switching circuit device of patent '280 also includes a protecting element comprising a first and second high concentration impurity regions and an insulating region therebetween and fully function as claimed.

8. Claims 20 and 25 are also rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 10-12 of U.S. Patent No. 6,946,891. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed protecting element has been covered by the protecting element of the patent '891.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 20, 24-31, 34, 36 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Asano et al. (U.S. Pub. No. 2002/0047177).

Asano teaches a protecting element as claimed including:

a first high concentration impurity region (161) formed in an insulating region (145) of a substrate (151) and connected to a first terminal (162) of an element formed in the substrate; and

a second high concentration impurity region (160) formed in the insulating region (145) and connected to a second terminal (170) of the element, the first (161) and second (160) high

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concentration impurity regions facing each other with a portion of the insulating region (145) disposed therebetween,

wherein a width of the first high concentration impurity region (161) is configured so that upon discharging of electrostatic energy applied between the first (162) and second (170) terminals a current path is formed in the insulating region (145) from an outer side surface of the first high concentration impurity region (161) to the second high concentration impurity region (160), the outer side surface of the first high concentration impurity region (161) being opposite from an inner side surface of the first high concentration impurity region that faces the portion of the insulating region (145). (See Figs. 3, 18A-C).

Regarding the functional limitation of: “the width of the high concentration impurity region is configured so that upon discharging of electrostatic energy applied between the first and second terminals a current path is formed in the insulating region from an outer side surface of the first high concentration impurity region to the second high concentration impurity region”, since the protecting element of Asano comprises the exact same elements as that of the claim, thus the element of Asano should inherently function the same way.

With respect to claim 22, the width of the second high concentration impurity region (160) of Asano is configured so that upon the discharging of the electrostatic energy applied between the first (162) and second (170) terminals the current path from the outer side surface of the first high concentration impurity region (161) inherently reaches an outer side surface of the second high concentration impurity region (160), the outer side surface of the second high



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concentration impurity region (160) being opposite from an inner side surface of the second high concentration impurity region that faces the portion of the insulating region (145). (See Figs. 3, 18A-C).

With respect to claim 24, the separation of the first (161) and second (160) high concentration impurity regions of Asano is 10  $\mu\text{m}$  or smaller.

With respect to claim 25, the separation of the first (161) and second (160) high concentration impurity regions of Asano is 4  $\mu\text{m}$  or larger.

With respect to claim 26, impurity concentration of the insulating region (145) of Asano is  $1 \times 10^{14} \text{ cm}^{-3}$  or lower.

With respect to claim 27, volume resistivity of the insulating region (145) of Asano is  $1 \times 10^3 \Omega \cdot \text{cm}$  or higher.

With respect to claim 28, the insulating region (145) of Asano is configured to provide an additional current path upon the discharging between the inner side surface of the first high concentration impurity region (161) and an inner side surface of the second high concentration impurity region (160) and between bottom surfaces of the first (161) and second (160) high concentration impurity regions.

With respect to claim 29, the first high concentration impurity region (161) of Asano comprises a branch portion that does not face the second high concentration impurity region (160) and is configured to provide upon the discharging an additional current path in the insulating region (145) between the branch portion and the second high concentration impurity region (160). (See Figs. 3, 18C).

With respect to claim 30, the current path of Asano inherently has a higher conductivity modulation than the additional current path.

With respect to claim 31, a current running through the current path of Asano upon the discharging is inherently greater than a current running through the additional current path upon the discharging.

With respect to claim 34, the current path of Asano inherently expands when the electrostatic energy applied between the first (162) and second (170) terminals becomes larger.

With respect to claim 36, the additional current path of Asano inherently has a higher conductivity modulation than the current path.

With respect to claim 38, the additional current path of Asano inherently expands when the electrostatic energy applied between the first and second terminals becomes larger.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 21, 23, 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asano '177.

With respect to claims 21 and 23, Asano teaches a protecting device as described in claim 22 above, thus, Asano is shown to teach all the features of the claim with the exception of the specific width of the first (161) and second (160) high concentration impurity region.

Note that the claimed range does not appear to be critical.

However, Asano further teaches that the first (161) and second (160) high concentration impurity region can be made smaller such that the insulating region 145 is located directly under the pad electrode 170 and wiring layer 162 consequently, the leakage of the high frequency signal applied to the pad to the wiring layer through the insulating region 145 is prevented.

Note that the specification contains no disclosure of either the *critical nature of the claimed width of the first and second impurity region* of any unexpected results arising therefrom. Where patentability is aid to based upon particular chosen dimension or upon another variable recited in a claim, the Applicant must show that the chosen dimension are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Within purview of one having ordinary skill in the art, it would have been obvious to determine the optimum width of the impurity regions to prevent leakage of high frequency signal applied to the electrodes. See *In re Aller*, Lacey and Hall (10 USPQ 233-237) "It is not inventive to discover optimum or workable ranges by routine

Furthermore, it would have been obvious to one having ordinary skill in the art at the time of invention to reducing the size of the impurity regions of Asano since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

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With respect to claim 33, Asano is shown to teach all the features of the claim with the exception of explicitly disclosing the thickness as claimed. Note that, the claimed thickness range of 20  $\mu\text{m}$  or larger appears to be common.

However, Asano teaches that a buffer layer of 6000 Å thickness has already prevent leakage.

Note that the specification contains no disclosure of either the *critical nature of the claimed thickness of 20  $\mu\text{m}$  or larger of the insulating portion under the impurity region* of any unexpected results arising therefrom. Where patentability is aid to based upon particular chosen dimension or upon another variable recited in a claim, the Applicant must show that the chosen dimension are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to form the protecting device of Asano on a thicker insulating layer to prevent leakage.

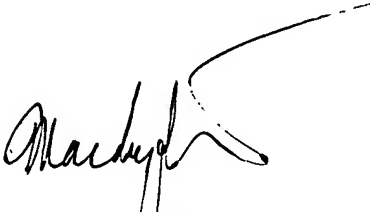
With respect to claim 35, the capacitance between the first (161) and second (160) high concentration impurity regions of Asano is propos ional to the volume resistivity of the insulating region between them. Since the insulating region (145) of Asano has a volume resistivity within the claimed range  $1 \times 10^3 \Omega \cdot \text{cm}$  or higher, thus, meets the capacitance of 40 fF or smaller, and the element of Asano inherently has a strength against electrostatic discharge at least 10 times as large as that of the element *without* the first and second high concentration impurity regions.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh D. Mai whose telephone number is (571) 272-1710. The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (571) 272-1705. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ANH D. MAI  
PRIMARY EXAMINER